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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,392	11/06/2001	David K. Locke	47079-0119	7604

7590 06/09/2003

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EXAMINER
MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/992,392	LOCKE ET AL.	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Specification

The use of the trademark MONOPOLY (page 7, lines 29 and 31) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 6, 8-10, 12, 13, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by SUPERIOR RACES (Superior Confection Company of Columbus Ohio, disclosed by Marshall Fey).

Superior discloses a slot machine that comprises a rotatable reel that bears a plurality of discrete symbols (colored horses) and a continuous graphical element (trail that inherently represents a road the horses must travel (as simulated by a race) on is connecting the horses) between adjacent discrete symbols such that the symbols are unified (FIG 1). The slot machine also includes means for rotating and stopping the reel (gears and motor from FIG 1) in order to

place the discrete symbols on the reel in visual association with a display (FIG 2, see horse symbols shown in display window). Further, it is notoriously well known in the art that the motors used in slot machines are stepper motors. The machine inherently possesses a means for determining a payout at least in part based on the discrete symbols displayed in the portion associated with the display area, as it is disclosed that the horses are in various colors to represent the type of payouts that are standard with a slot machine (Fey). Further, the reel will inherently be rotated which will cause the discrete symbols to move between the adjacent ones of the discrete symbol positions as the reel is rotated. The payout will hence then be determined based on the result of the movement of the discrete symbols to other adjacent symbol positions as the reel is rotated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 18, 20, 21, 23-26, 28, 29, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over SUPERIOR RACES (Superior Confection Company of Columbus Ohio, disclosed by Marshall Fey).

What SUPERIOR RACES (Superior Confection Company of Columbus Ohio, disclosed by Marshall Fey) discloses has been discussed above and is incorporated herein.

Superior does not disclose that the slot machines is controlled by a processor or that a player can place a wager; however, it is notoriously well known in the art that when a slot machine has payout odds, as disclosed by Superior, that the player inherently places a wager in order to be able to play the game and it would have been obvious to one of ordinary skill in the art that the machine should duly encompasses a processor to control the gaming device in order to retain the disclosed payout ratio and to retain a set percentage controlled by a paytable of profit for the house.

Claims 4, 7, 11, 14, 19, 22, 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over SUPERIOR RACES (Superior Confection Company of Columbus Ohio, disclosed by Marshall Fey) in view of Taylor (US Patent No. 6,569,013).

What SUPERIOR RACES (Superior Confection Company of Columbus Ohio, disclosed by Marshall Fey) discloses has been discussed above and is incorporated herein.

Superior does not disclose that the gaming device is available in a simulated video display.

However, it is well known in the art that it is notoriously well known and thus would be obvious to automate mechanical reel slot machines into simulated video display in order to build cheaper and longer lasting machines. Taylor supports this fact in disclosing that a traditional non-video slot machine equipped with mechanical reels is largely the same as a video slot (Column 1, lines 63-65).

Therefore, because of the fact that changing a mechanical slot into a video slot is so well-known and based upon the fact, as disclosed by Taylor, that both types of machines are largely the same, it would have been obvious to one of ordinary skill in the art to simulate the device of Superior into a video display wherein the symbols and the reel are simulated in order to allow for the machine to be a cheaper manufacture. Further, in order to accomplish this incorporation, one of ordinary skill in the art would have to superimpose the symbols over the graphical element in order to keep the same functionality and appearance as shown in the Superior gaming device.

Claims 17 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over SUPERIOR RACES (Superior Confection Company of Columbus Ohio, disclosed by Marshall Fey) in view of Gerrard et al. (US Patent No. 6,494,785).

What SUPERIOR RACES (Superior Confection Company of Columbus Ohio, disclosed by Marshall Fey) discloses has been discussed above and is incorporated herein.
Superior discloses that the payout is determined based upon the result of the movement of the symbols between different symbol positions.

Superior does not disclose that a payout accumulates based on the position traversed by each the discrete symbol.

Gerrard et al. teach of a bonus game wherein a symbol traverses from position to position with an aim of reaching a destination location (Abstract). The bonus paid to the player is based upon the position traversed by the player and the bonus accumulates as the player gets closer to the destination (Column 7, lines 44-47). Gerrard et al. also discloses that this type of bonus scheme adds excitement to bonus rounds and increases player entertainment (Abstract).

Though Superior does not disclose the use of the bonus game, the state of the art at the time of conception of the game was not that which it is now. Presently in the state of the art, it is notoriously well known to use bonus features as a means to enhance the player's perception of receiving a larger award.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate such a bonus game into the system of Superior. Further, it would have been obvious to incorporate a bonus game as disclosed by Gerrard et al. into the gaming device of Superior. One of ordinary skill in the art would be motivated to make this incorporation as the bonus game of Gerrard et al. involves a racing theme that is already present in the device of Superior. Further, one of ordinary skill in the art would be motivated to use the Gerrard et al. bonus feature as it is disclosed the type of bonus scheme disclosed by Gerrard et al. adds excitement to the bonus round and increases the player entertainment which are well known goals in the gaming industry.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,565,433: Gaming device that allows symbols to move along a path within the gaming device wherein the path connects the symbols which are superimposed over the path which is in the form of a road.

US Patent No. 6,406,369: Gaming device that has a bonus scheme where players take part in a competition involving a race.

US Patent No. 6,419,579: Slot machine with a video display which has a plurality of wheels wherein the indicia displayed on the wheels can move along the screen.

US Patent No. 5,664,998: Racing apparatus wherein a symbols move across a graphical element to compete in a race.

US Patent No. 6,520,855: Gaming apparatus that provides a board game wherein a piece can move about the board in a bonus round.

US Patent No. 6,464,581: Continuous reel for presentation on a gaming machine wherein the reel forms a presentation of a track.

US Patent No. 6,554,704: Gaming device where characters can move along a path as well as having a continuous graphical element wherein the characters are superimposed over the element.

US Patent No. 6,517,433: Gaming device wherein symbols are superimposed on a continuous graphical element that connects the symbols.

US Patent No. 6,120,376: Gaming device that has a plurality of paths wherein a race can occur between one or more racing members within the path.

US Patent No. 5,980,384: Gaming apparatus that displays a number of continuous paths between the symbols including arrows and ladders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE, can be reached on (703)-308-1118. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

cmm
May 28, 2003

MICHAEL O'NEILL
PRIMARY EXAMINER